

**REMARKS/ARGUMENTS**

In the Final Office Action, paragraph 2, Robert H. Mullis is identified as not being qualified to sign the submitted 37 CFR 1.131 declaration. In response, a new declaration under 37 CFR 1.131 is enclosed from Russel D. Slifer, Chief Patent Counsel for and authorized representative of Micron Technology, Inc.

In addition, the Examiner expressed concerns over substantive deficiencies in the 37 CFR 1.131 submission in the Final Office Action, paragraph 4. It is respectfully submitted that the attached declaration demonstrates that the subject matter of the instant application was conceived at least as early as June 27, 2001, and diligence has been shown for the time period beginning prior to the effective date of the Allen, et al., reference and ending at the constructive reduction to practice of the invention occurring at filing. As a result, the Allen, et al., reference is ineffective against the 10/002,461 application.

37 CFR 1.131(a) states that a qualified party may submit a declaration to establish invention of the subject matter of a rejected claim prior to the effective date of the reference on which the rejection is based. 37 CFR 1.131(b) states that the showing of facts shall be such as to establish conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice). See also MPEP 715.07(III).

Conception is the mental part of the inventive act. It must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724 (D.C. Cir. 1897); MPEP Form Paragraph 7.61.

The essential thing to be shown under 37 CFR 1.131 is priority of invention, and this may be done by any satisfactory evidence of the fact. Facts, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the declaration. Each exhibit relied upon

should be specifically referred to in the declaration in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting sketches, blueprints, photographs, and reproductions of notebook entries as evidence. MPEP 715.07(I).

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner has been diligent. Rather, applicant must show evidence of facts establishing diligence from just prior to the effective date of the reference to the actual or constructive reduction to practice. MPEP 715.07(a).

The Applicant relies on the Disclosure document of June 27, 2001, included in Exhibit 1 as Exhibits A, B, and C, as evidence of conception of the invention. The drawings, Exhibit C, show more than a vague idea of how to solve the problem. The drawings show a comprehension of the requisite means and their interaction in detailed circuit diagrams. As Mr. Slifer states in his declaration included as Exhibit 1, the figures in the Invention Disclosure form correspond to the figures and support the claims of the 10/002,461 application. Thus, it is respectfully submitted that these drawings combined with all of the evidence presented in its entirety prove conception of the claimed invention at least as early as June 27, 2001.

The application was filed in a prompt manner on November 1, 2001, four months and five days following receipt of the invention disclosure form. The timeline for preparation of the application is detailed in the undersigned attorney's declaration attached as Exhibit 2. The timeline illustrates the diligent preparation of the application. Thus, it is respectfully submitted that there is no issue as to lack of diligence between the effective date of the reference, August 24, 2001, and the date of constructive reduction to practice, November 11, 2001.

It should be emphasized that these remarks make no attempt to establish actual reduction to practice. These remarks seek only to establish conception of the invention and diligence during the period beginning prior to the effective date of the Allen, et al., reference to the constructive reduction to practice occurring at the filing of the 10/002,461 application as permitted by the third option in 37 CFR 1.131(b).

It is respectfully submitted that applicant has demonstrated a conception date earlier than the effective date of Allen, et al., and has demonstrated diligence from prior to the effective date of the Allen, et al., reference until the filing of the application. It is therefore applicant's position that Allen, et al. may not be relied upon by the Office in rejecting the claims of the instant application. As the only rejection of the claims of the instant application is based on Allen, et al., it is believed that the instant application is now in condition for allowance.

Applicant has made a diligent effort to place the instant application in condition for allowance. The issue fee for this application has already been paid. Accordingly, it is respectfully requested that the instant application be passed to issue so that a patent may be issued for claims 1-38 and 41-44. If the Examiner is of the opinion that the instant application is in condition for disposition other than through issuance, the Examiner is respectfully requested to contact applicant's attorney at the telephone number listed below.

Respectfully submitted,



Edward L. Pencoske  
Reg. No. 29,688  
Jones Day  
500 Grant Street, 31st Floor  
Pittsburgh, PA 15219  
(412) 391-3939